REMARKS/DISCUSSION OF ISSUES

Claims 1-16 are pending in the application. Claims 1,5,9 and 13 are the independent claims.

Rejections Under 35 U.S.C. § 103

The Office rejects claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over *Tzeng* (U.S. Patent 5,293,449) in view of *DeJaco* (U.S. Patent 6,484,138), further in view *Su* (U.S. Patent 5,664,054). For at least the reasons set forth below, it is respectfully submitted that this rejection is improper and should be withdrawn.

The establishment of a *prima facie* case of obviousness requires that *all* of the elements be found in the prior art. It follows, therefore, if a single element is not found in the prior art, a prima facie case of obviousness cannot properly be established. Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a teaching, suggestion or motivation to do so found in the references relied upon. However, hindsight is never an appropriate motivation for combining references and/or the requisite knowledge available to one having ordinary skill in the art. To this end, relying upon hindsight knowledge of applicants' disclosure when the prior art does not teach nor suggest such knowledge results in the use of the invention as a template for its own reconstruction. This is wholly improper in the determination of patentability.

Claims 1, 5, 9 and 13 each feature, *inter alia*,

"*...provided an input signal is received having an* ***energy value lower than said input energy threshold value****, using a selection process such that said suspected noise-inducing codebook excitation is not continuously generated...*"

It is respectfully submitted that the applied art lacks at least the disclosure of this feature of the independent claims. The Office Action asserts that the reference to *Tzeng* discloses "'provided an input signal...continuously generated' as measuring the amount of energy in the signal, and choosing either a voice codebook or unvoiced codebook (col. 8 lines 11-48)..."

Initially, it is noted that the Office Action does not clearly address all features of paragraph 'b)' set forth in these claims. As such, it is respectfully submitted that the Office Action does not meet the requirement of providing a clearly articulated rejection under MPEP § 706. Therefore, it is respectfully submitted that the Office Action is improper and should be withdrawn.

In addition, it is respectfully submitted that the reference to *Tzeng* lacks at least the disclosure of the selection process based on an input energy threshold value. Rather, *Tzeng* discloses an analysis-by-synthesis approach, in which an excitation model circuit receives a distortion analysis signal for each applied excitation signal and compares he distortion analysis signals. The circuit determines which of the excitation signals that provide optimal reconstructed speech. Moreover, the reference discloses a codebook arrangement having a menu of possible excitation signal models.

The codebook arrangement is for a voiced excitation generator 408 and a Gaussian noise generator. For the analysis by synthesis operation the voiced excitation codebook 408 outputs each of a possible codebook pulse train having a different pitch period; and the Gaussian noise generator outputs each of a plurality of Gaussian sequences for use as an excitation signal. Each Gaussian sequence has a different random sequence. However, it is noted that *using a selection process such that said suspected noise-inducing codebook excitation is not continuously generated* in the event that *an input signal is received having an* ***energy value lower than said input energy threshold value*** as is featured in claims 1, 5, 9 and 13 is not disclosed in the reference to *Tzeng*. (Kindly refer to column 7, line 30 through column 8 line 49 of *Tzeng* for support for the above assertions.)

For at least the reasons set forth above, it is respectfully submitted that the applied art lacks at least the disclosure of one of the features of independent claims 1, 5, 9 and 13. Therefore, these claims and the claims that depend therefrom are patentable over the applied art for at least the reasons set forth above. Allowance is earnestly solicited.

While the pending claims are allowable for at least the reasons set forth above, Applicants also respectfully traverse the propriety of the present rejection for additional reasons. To wit, it is submitted that the Office Action attempts to fabricate a patchwork mosaic of various pieces of prior art based on Applicants' teachings. Not only do the disclosures of the applied art lack at least the features of the claims as discussed above, it is submitted that the requisite motivation to combine the references is not provided. In particular, the

rejection provides certain benefits of one reference as a motivation for combining this reference with another. This does not provide the motivation to combine the reference. Rather, there must be a suggestion in the reference for its combination. It is respectfully submitted that the requisite motivation has not been provided from the references themselves.

Accordingly, for at least this reason Applicants respectfully submit that the present rejection is improper and should be withdrawn.

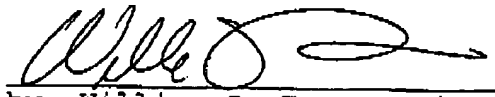
Conclusion

In view of the foregoing, it is respectfully requested that all objections and rejections be withdrawn. Allowance of all pending claims is earnestly solicited.

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact William S. Francos, Esq. (Reg. No. 38,456) at (610) 375-3513 to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to those fees provided under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.



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